

No. 50.

IN THE
UNITED STATES CIRCUIT COURT OF APPEALS
FOR THE NINTH CIRCUIT.

CONSOLIDATED PIEDMONT CABLE COMPANY,
APPELLANT,
v/s.

PACIFIC CABLE RAILWAY COMPANY,
APPELLEE.

BRIEF OF APPELLANT.

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BRIEF OF APPELLANT.

This suit was brought to recover for an alleged infringement of United States Letters Patent No. 189,204, bearing date April 3d, 1877, granted to William Eppelsheimer, for an improvement in cable grips, and duly assigned to the appellee.

The opinion of his Honor, Judge Hawley, before whom the suit was tried, was orally delivered on the 29th day of February, 1892, and an interlocutory decree in favor of the complainant was entered on the 3d day of March. From that decree the respondent has duly perfected its appeal to this Court.

As will be seen from an examination of the patent sued on (transcript, p. 48), that patent was granted, not for a *primary invention*, as the term is used in patent law, but for an *improvement* on an invention or inventions already in existence when it was granted. The descriptive phrase preceding the specification is: "Improvement in Clamps for Endless-Rope Railways." The patentee says: "Be it known that I * * * have invented an improved clamp apparatus," etc. Every one of the seven claims of the patent was for a combination of pre-existing elements, and none was for the invention of any specific thing.

Claim 3 of the patent was the only one alleged at the trial to have been infringed, and it reads as follows:

"3. The combination with the shank *E*, as described, of "the hinged clamping-jaws *e*³, together with the operating "slide *F*, its cross-bar *f*², and bearing rollers *f*, as and for the "purpose specified."

The defense was non-infringement, and we think the learned Judge before whom the case was tried entirely overlooked the distinction which has so often been pointed out by the highest Court of the land between primary and secondary patents, in the application of the doctrine of equivalents.

The following errors are assigned by the appellant:

1.

That the Circuit Court of the United States for the Northern District of California erred in holding that the appellant herein infringed upon the third claim of the letters patent sued upon.

2.

That the said Court erred in holding that the alleged infringing grips contained the combination called for in the third claim of the appellee's patent, inasmuch as the evidence showed that there were no bearing rollers in the alleged infringing grips as called for by said claim and no equivalent therefor.

3.

That the said Court erred in holding that the loose pins fitted in the outer portion of the jaws of the appellant's grips are the equivalents of the friction or bearing rollers of the combination covered by the third claim of the appellee's patent.

4.

That the said Court erred in holding that the appellant's grip effects substantially the same result in substantially the same way as the appellee's grip.

5.

That the said Court erred in ordering an interlocutory decree against the appellant, ordering, adjudging and decreeing that the appellee is entitled to an injunction, and decreeing a reference to the Master in Chancery of said Court for an accounting.

We beg leave first to direct the attention of the Court to certain well known rules of patent law, viz:

1st. That the patent only covers *what its claims cover*. No matter what is described in the specifications and drawings of the patent, its claims alone determine what is secured to the patentee.

2d. That whatever is shown in the specifications and drawings of the patent and is not covered by its claims, *is conclusively admitted by the patentee to be old, and no part of his invention*.

3d. When a claim is for a combination, there can be no infringement of that claim *unless the entire combination is used* by the defendant.

The law on these points is nearly all found recited in the case of *Rowell vs. Lindsay*, 113 U. S., on pages 101 and 102. The Supreme Court there says, referring to a former case:

“As was said by Mr. Justice Bradley, in the case of the Corn-

“ Planter Patent, 23 Wall., 181, 224: ‘ Where a patentee, after
 “ ‘ describing a machine, claims as his invention a certain
 “ ‘ combination of elements, or a certain device, or part of the
 “ ‘ machine, this is an implied declaration, as conclusive so far
 “ ‘ as that patent is concerned as if it were expressed, that the
 “ ‘ specific combination or thing claimed is the only part which
 “ ‘ the patentee regards as new. True, he or some other person
 “ ‘ may have a distinct patent for the portions not covered by
 “ ‘ this; but that will speak for itself. So far as the patent in
 “ ‘ question is concerned, the remaining parts are old or com-
 “ ‘ mon and public.’ See also *Merrill vs. Yeomans*, 94 U. S.,
 “ 568, 573; *Water Meter Co. vs. Desper*, 101 U. S., 332, 337;
 “ *Miller vs. Brass Co.*, 104 U. S., 350. These authorities dis-
 “ pose of the contention of the plaintiff’s counsel, that their
 “ patent covers one of the separate elements which enters into
 “ the combination, namely, a slotted wooden beam, because,
 “ as they contend, that element is new, and is the original
 “ invention of the patentees. The patent being for a combina-
 “ tion, there can be no infringement unless the combination is
 “ infringed.

“ In *Prouty vs. Ruggles*, 16 Pet., 336, 341, it was said: ‘ This
 “ ‘ combination, composed of all the parts mentioned in the
 “ ‘ specification, and arranged with reference to each other,
 “ ‘ and to other parts of the plough in the manner therein
 “ ‘ described, is stated to be the improvement and is the thing
 “ ‘ patented. The use of any two of these parts only, or of two
 “ ‘ combined with a third which is substantially different, in
 “ ‘ form or in the manner of its arrangement and connection
 “ ‘ with the others, is, therefore, not the thing patented. It is
 “ ‘ not the same combination if it substantially differs from it
 “ ‘ in any of its parts. The jogging of the standard into the
 “ ‘ beam, and its extension backward from the bolt, are both
 “ ‘ treated by the plaintiffs as essential parts of their combina-
 “ ‘ tion for the purpose of brace and draft. Consequently, the
 “ ‘ use of either alone, by the defendants, would not be the
 “ ‘ same improvement nor infringe the patent of the plaintiffs.’
 “ To the same effect see also *Stimpson vs. Baltimore and Sus-
 “ quehanna Railroad Co.*, 10 How., 329; *Eames vs. Godfrey*, 1
 “ Wall., 78; *Seymour vs. Osborne*, 11 Wall., 516; *Dunbar vs.*
 “ *Myers*, 94 U. S., 187; *Fuller vs. Yentzer*, 94 U. S., 288.

“ But this rule is subject to the qualification, that a combina-
 “ tion may be infringed when some of the elements are em-
 “ ployed, and for the others mechanical equivalents are used
 “ which were known to be such at the time when the patent
 “ was granted. *Seymour vs. Osborne*, *ubi supra*; *Gould vs. Rees*,
 “ 15 Wall., 187; *Imhaeuser vs. Buerk*, 101 U. S., 647.

“ In the light of these principles, we are to inquire whether

“ the defendants use the combination described in the patent
 “ of the plaintiffs. The contention of the defendants is that
 “ the brace-bar, which is one of the elements of the combina-
 “ tion covered by the patent of the plaintiffs, is not, nor is its
 “ equivalent, found in the machines made and sold by them.
 “ It is plain, upon an inspection of the drawings, that the de-
 “ fendants do not use a brace-bar similar in shape or position
 “ to that described in the plaintiff’s patent.

“ But the plaintiffs insist that the top of the shank, curved
 “ as shown in Thomas’ patent, is the equivalent of the brace-
 “ bar forming one of the elements of their invention; and as
 “ the contrivance of the defendants embodies this equivalent
 “ device in combination with all the other elements covered
 “ by the plaintiff’s patent, that the infringement is established.
 “ Whether the first mentioned device is the equivalent of the
 “ latter is the question for solution. We think the contention
 “ of the defendants that it is not, is well grounded. The
 “ specification and drawings of the plaintiffs’ patent, and the
 “ testimony of the plaintiff’s witnesses, show that one purpose
 “ of the brace-bar, used in the plaintiffs’ combination, was to
 “ strengthen and support the shank between the tooth and the
 “ beam. The use of the brace-bar enabled the plaintiffs to
 “ make the shank with less material, and at the same time to
 “ increase its strength. This function is not performed by the
 “ curved portion of the shank used by the defendants, which
 “ has not the slightest tendency to support and strengthen the
 “ shank between the tooth and the beam, where the greatest
 “ strain comes. On the contrary, the defendants, by reason of
 “ the absence of the brace-bar, are forced to make their shank
 “ of larger diameter than that used by the plaintiffs in order
 “ to give it the requisite strength to prevent bending. Instead
 “ of stiffening the shank between the tooth and the beam, it
 “ rather brings an increased strain upon that part of the
 “ shank. We find, therefore, that the curved upper part of
 “ the shank used by defendants does not perform one of the
 “ material functions of the brace-bar of the plaintiff’s com-
 “ bination. It cannot, therefore, be the equivalent of the
 “ latter. For where one patented combination is asserted to
 “ be an infringement of another, a device in one to be the
 “ equivalent of a device in the other must perform the same
 “ functions.

“ As, therefore, there is one element of the plaintiffs’ pat-
 “ ented combination, which the defendants do not use and for
 “ which they do not employ an equivalent, it follows that they
 “ do not infringe the plaintiff’s patent.”

This authority and the several decisions which are cited in it
 seems to us to cover all the law that is applicable to this, the

case at bar. Other cases almost without number sustain the same elementary rules.

An equivalent is defined to be “ a thing which *performs the same function*, and performs that function in substantially the same manner, as the thing of which it is alleged to be the equivalent.”

Walker on Patents, 358.

It is absolutely certain that there is nothing in the appellant's mechanism which performs, or is adapted to perform, or can perform, the *same functions* as are performed by the bearing rollers “ *f* ” of the appellee's patented combination. The bearing rollers, with whatever functions they may perform, are entirely absent from appellant's grip. “ Therefore,” adopting the language quoted above to this case, “ as there is one element of the plaintiff's patented combination which the defendants do not use, and for which they do not employ an equivalent, it follows that they do not infringe the plaintiff's patent.”

It may be argued that the swinging jaws were the patentee's invention. This may or may not be so as a fact. Mr. Eppelsheimer may have conceived the idea of the swinging jaws before any one else did, or he may have learned how to apply them in a grip by having them urged upon his attention by some one else. If they were his own invention *he had the right to claim them by a specific claim made in the patent for the application of swinging jaws in a cable grip*. If he was not the inventor of them, and had put in such a claim, we could have defeated the claim by proving that he was not the inventor but that he learned it of another. If he was not the inventor of the swinging jaws he had no right to claim them by themselves. Under the foregoing decision of the U. S. Supreme Court, by not claiming them in his patent, *he conclusively admits that he did not invent them*. The patent is to be construed therefore just as though it had been proven as a fact that the patentee did not invent the swinging jaws himself but took them from some other person and merely used them as an element in the combination of devices which make up the grip of the patent.

Referring now to the patented grip, and to the appellant's grip, and to the appellee's admission that only one out of the seven claims of the patent is infringed by the appellant's grip, and we have a very important fact established at the outset. If only one claim out of the seven claims of the patent which cover all the patentee's inventions is infringed, it must be obvious that the appellant's grip, *so far as the patented inventions go*, must be constructed on a very different plan and mode of operation from the grip of the patent. The general operation of all the grips is the same. The testimony (transcript,

pages 34, 37, 38) shows that the grip of the patent was not the first grip for cable railways.

As the testimony of Mr. Bell shows on pages 34, 37 and 38 of the transcript, the grip used on the Clay street road was much older than the grip of the patent. Of course nothing that was in that old grip could be covered by the present patent. In that old grip there were the elements which are described in the complainant's patent as the shank *E*, also the operating slide *F*, both performing the same operations as those shown in the patent. It also had a frame that was fastened to the dummy or car, so that it could not move up or down, and which frame carried a part of the gripping device, while within said frame there was a sliding vertical rod that carried at its lower end the remaining parts of the gripping device. (Transcript, page 34.) The jaws of the old grip were a combination of rollers and dies, and their power was secured by a combination of a wedge (this wedge was below in the grip, although the witness does not distinctly say so) and a screw above. The grip of the patent works with a lever above instead of a screw.

As the old grip had all the necessary operative working parts, and had them arranged and combined into an operative working grip, it follows that the patent could not legitimately cover those parts by themselves, nor could it cover their general arrangement in an operative working grip. Proving the old grips of the Clay street road was proving what is known in patent law as "The State of the Art." That is, it was proving what had been done in the art of grip making before the patentee invented the improvements which his patent covered. As a patentee can only have a valid patent for that of which he was the *first*, as well as the original inventor, the patent in this case would be null and void if it covered what was in the old Hallidie grip that was used on the Clay Street Cable road.

Proof of the state of the art is put in when the patentee undertakes to assert a right to the principle upon which his invention operates. This he may do if his machine is the *first of its kind*, but not otherwise. The man who invents the first machine of its kind may cover the principle of its operation because that principle is a part, and the most important part of his invention. If, however, the machines already exist he can only invent an improvement to the machine. Even then he may cover the principle of any new operation which his improvement for the first time introduces into the structure. He does not however introduce any new principle of operation in cases in which his invention consists in applying new devices to do the same things as the old devices did in the old machines. In such case his new devices are only mechanical equivalents of the old devices. In such cases others may use

other mechanical devices for doing the same thing, and although the devices so used by others will be mechanical equivalents of the devices which the inventor of the improvement *uses* they are not mechanical equivalents of *what he invented*. The second inventor's use of mechanical equivalents of devices that the first inventor used does not permit such second inventor to claim other mechanical equivalents of the devices used by the first inventor, because such second inventor has not invented those other mechanical equivalents, nor did he invent the general application of operative devices of that general kind to that class of machines. As Howe was the first to invent a sewing machine of any kind he compelled every sewing machine maker to pay him a royalty on their machines until his patent expired; but although the subsequent sewing machine makers had new improvements of their own and had special patents for such new improvements, still they could seldom make their new inventions cover each other for the reason that the inventions and patents of Howe always loomed up against their pretensions as original discoverers of the principles upon which the sewing machines operated.

Duff vs. Sterling Pump Co., 107 U. S. (see page 639), was a case in which the doctrine of mechanical equivalents could not be applied. On the other hand, the case of *Morley Machine Co. vs. Lancaster*, 129 U. S., 263, was a case where the invention was a pioneer one, and there the rule of mechanical equivalents could be and was applied. When the inventor has made a pioneer invention and is the first to incorporate into a machine the principle of operation upon which his invention operates, he is permitted to cover that principle of operation by invoking the doctrine of mechanical equivalents. This is the only way it can be done, as the law does not permit the patenting of a principle in terms. It is only accomplished by allowing the inventor to claim that his patent covers not only the special devices and arrangement of parts that go to make up his machine, but also other devices so arranged as to accomplish substantially the same mode of operation.

In the above cited case of *Morley Sewing Machine Co. vs. Lancaster*, 129 U. S., the Supreme Court takes up the space from page 272 to 283 in discussing this exact question and citing the leading authorities upon the subject. A careful reading of that part of the case covering the pages last mentioned, will give a person a full, correct and ample knowledge of this branch of patent law. When this feature of the patent law is well understood and applied to the testimony in the case at bar, the reason why the appellee's patent is confined to combinations of devices, and why it does not assert any right to any general principles in its claims is apparent. It is not a patent on the first grip

that was ever made. As it says at the head of the specifications, it is an "improved," not an original, "clamp apparatus," etc. Reading the specifications through, they show, as it was right and proper they should show, that the patentee was not the original inventor of the grips used on cable railways. The specifications of the patent agree with the testimony given in the case.

The learned Judge of the Court below said, in his opinion (transcript, page 13): "The defendant's grip effects substantially the same result, in substantially the same way as the complainant's grip." This language constitutes a generalization which, even if literally true, may be inapplicable and misleading, as we think it was and is in this case. Set phrases are sometimes dangerous. A rule which is applicable to the facts of a given case may be deceiving when invoked in another case. This is well illustrated by the evident effect that the language above quoted had upon the mind of the lower Court. If the patent of the appellee had been for a *primary invention*, then the appellant might be held to infringe because effecting "substantially the same result in substantially the same way." But it does not follow that the same rule would hold between the patentee of a *secondary invention* and his alleged infringer.

"If the patentee be the original inventor of the device or machine called the divider, he will have a right to treat as infringers all who make dividers operating on the same principle, and performing the same functions by analogous means or equivalent combinations, even though the infringing machine may be an improvement of the original, and patentable as such. But if the invention claimed be itself but an improvement on a known machine by a mere change of form or combination of parts, the patentee cannot treat another as an infringer who has improved the original machine by use of a different form or combination performing the same functions. The inventor of the first improvement cannot invoke the doctrine of equivalents to suppress all other improvements which are not mere colorable invasions of the first."

McCormick vs. Talcott, 20 How., 405.

"In such cases, if one inventor precedes all the rest, and strikes out something which includes and underlies all that they produce, he acquires a monopoly, and subjects them to tribute. But if the advance toward the thing desired is gradual, and proceeds step by step, so that no one can claim the complete whole, then each is entitled only to *the specific form of device which he produces*, and every other inventor is

“entitled to *his own specific form*, so long as it differs from those of his competitors, and does not include theirs.”

Railway Co. vs. Sayles, 97 U. S., 556.

The first inventor of a sewing machine might successfully maintain a suit for infringement against one who constructed a machine that would sew in “substantially the same way.” But the case of a second inventor, whose claim to inventive genius rests solely upon an alleged discovery of the beneficent operation of *old elements in combination*, would be determined according to altogether different rules, as will be seen from the cases last cited above.

The rule as to the application of the doctrine of equivalents, in the case of patents for combinations, all producing the same results, but different in their forms of combination, is stated in *Hill vs. Sawyer*, 31 Fed. Rep., 285: “The defendant’s rolls are not the rolls of the patent, and, although they produce similar results, they cannot be regarded as equivalents. This case, it is thought, belongs to that class of inventions where the doctrine of equivalents cannot be invoked to suppress improvements on a well known machine. Where change of form or combination only is involved, each inventor must be content with the structure described and claimed by him.” See also:

Tobey Furniture Co. vs. Colby, 26 Fed. Rep., 100.

And it must not be forgotten that the appellee in this case is indisputably in the position of the patentee of a secondary invention. Cable grips, accomplishing substantially the result accomplished by all cable grips, were known to the art before the date of the appellee’s patent. He has not claimed in his patent to be the inventor of any specific element contained in his combination. He only warned the public, by his application for a patent, of his claim to *the combination*. And as we have seen in the Corn-Planter case, cited above, “Where a patentee, after describing a machine, claims as his invention a certain combination of elements, or a certain device, or part of the machine, this is an implied declaration, as conclusive so far as that patent is concerned as if it were expressed, that the specific combination or thing claimed is the only part which the patentee regards as new.”

It is a rule of patent law that the inventor is bound by the claims which he makes, or accepts from the Patent Office, even when that office compels the applicant for a patent to modify the claims which he originally makes, as a condition of granting the patent. However meritorious the invention may be, and however much the inventor may be legally and morally en-

titled to a patent that will be a full protection to him for his invention, he yet owes something to the public. The law requires that he shall describe *and claim* his invention in distinct terms so that the public may know what the invention is which he claims. He must make his claims distinct and plain so that persons skilled in the art or mechanism to which the invention belongs may know when they are infringing and when they are not infringing. This is but a small requirement from the inventor. It is only just and reasonable to the public. The law says, and the Courts have decided that he must do it. The following authorities are very pointed upon this proposition:

Merrill vs. Yeomans, 94 U. S., pages 573 and 574.

Keystone Bridge Co. vs. Phoenix Iron Co., 95 U. S., 274.

Burns vs. Meyer, 100 U. S., latter part of the decision on page 672.

White vs. Dunbar, 119 U. S., latter part of page 51 and first part of page 52.

James vs. Campbell, 104 U. S., last half page 370.

The admission that six of the claims of the patent are not infringed by what the appellant uses shows that the appellant has not copied after the patented improvements. The improvements of the appellant must be of an entirely different character from the patented improvements in their general scope and operation and plan of action, or there would certainly be more than one of the seven claims of the patent infringed. It is asserted that the appellant's grip infringes the third claim of the patent. This third claim is a combination claim pure and simple, and it is nothing but a claim for a combination. It is as follows:

“The combination, with the shank *E*, as described, of the hinged clamping jaws *e*³, together with the operating slide *F*, its cross-bar *F*², and bearing-rollers *f*, as and for the purpose specified.”

Comparing the appellant's grip with the patented grip, we find that both have the shank *E*; both have the operating slide *F*, with its cross-bar *f*², and both have hinged clamping jaws. The patented clamping jaws, as described in the patent, are made as follows: “The outward faces of these jaws are *inclined outwardly* from the hinge-joint to their lower edges, as shown at *e*⁴, Fig. 3, and upon these faces are arranged to bear friction rollers *f*, which are mounted on axles *f*¹, arranged above the jaws, and fixed in, and carried by, a cross-piece, *f*², which is fixed on the lower end of the slide *F*.”

A careful consideration of the foregoing description, copied from the patent, disperses the idea of there being in the appel-

lant's grip any possible equivalent or substitute of the friction rollers. In the patented grip there are the swinging jaws made with *faces that "are inclined outwardly."* The two faces together constitute a wedge having its widest end downwards. On account of this wedge shape it is possible to operate them by the aid of the friction rollers. To apply the friction rollers there are used, as explained in the patent, the slide *F*, with a cross-bar across its lower end, and which cross-bar carries the axles *f*¹, and on these axles *f*¹ are mounted the friction rollers *f*. These friction rollers must bear upon the inclined faces of the jaws at points below the point where the jaws are pivoted together, while in the appellant's grip the jaws are in the nature of bell cranks and the pin which presses down upon them may be, and is, applied at points on the same level with the point where the jaws are pivoted together, or above or below that point. In practice the three points average to be on a level, the pins which move the jaws passing in their movements a little above, and also a little below, the point of pivoting mentioned. This difference in the construction and operation of the two grips is well explained by Mr. Bell and the drawing—"Exhibit 2"—which he used to explain his testimony, and which drawing contains seven distinct sketches. This drawing is a part of the testimony. The first three sketches on it illustrate the patented grip, and the last four sketches illustrate the appellant's grip. The testimony of Mr. Bell, as well as the cross-examination of Mr. Smyth, show plainly that the two grips are entirely different in the following respects, viz:

The patented grip has the outside faces of its jaws inclined, and it has friction rollers to bear upon those inclined faces. The appellant's grip does not have or operate with any inclined faces on its jaws, and it does not have any friction rollers or any equivalent of friction rollers contained in it, either for the purpose of bearing upon such inclined surfaces or for any other purpose. The friction roller cannot be read into appellant's grip. Counsel has heretofore taken the position that claim three of the patent should be read so as to give the grip but four elements, these four elements to consist of—1, the shank; 2, the jaws; 3, the slide; 4, the *mechanism* by which the power of the slide is transmitted to the jaws.

The objection to this construction is that it is not justified by the descriptions contained in the specifications. *No such claim is made in the patent.* If the patentee supposed that such was his invention *he should have claimed it.* Such claims are made in patents when the patentee is entitled to make them. In the case of *Robertson vs. Blake*, 94 U. S., 728, *such a claim was made in the patent* and sustained by the Courts. The patent was on a new rock-crushing machine. The machine was the first of

its kind. The patent had three claims (see page 729). The first claim was "a combination of a stone-breaking machine of upright converging jaws with a revolving shaft, *and mechanism* imparting a definite reciprocating movement to one of the jaws from the revolving shaft, the whole being and operating as set forth."

In this Blake patent the "mechanism" that transmitted the power from the revolving shaft to the crushing jaws consisted of a system of metal compound levers which furnished an immense leverage power against the jaws. The defendants substituted for this system of the patent a well-known hydraulic leverage power which produced the same result, operating the jaws in the same way and with the same motion and same amount of power. The claim was for the "*mechanism*" as one of the elements of the combination. The Courts held that the *mechanism* substituted by the defendants was the equivalent of the *mechanism* of the patent.

In the patent at bar *the claim does not call for "mechanism" as an element* in the combination, but it calls for a combination of the several devices as elements of the combination which make up the combination, *particularly specifying each one of the devices as one of the elements* of the combination claimed. The rule of law applies that there is no infringement of a combination claim, so long as *one of the devices specified in the claim as one of the elements* of the combination is omitted from the defendant's machine. This is one of the most elementary and most universally sustained rules of patent law.

Coolidge vs. McCone, 2 Sawyer, page 576.

Matteson vs. Caine, 8 Sawyer, 498.

Prouty vs. Ruggles, 16 Peters, 336.

Gould vs. Rees, 15 Wallace, 187.

Gage vs. Herring, 107 U. S., 640.

Sargeant vs. Hall Safe and Lock Co., 114 U. S., page 86.

Rowell vs. Lindsay, already quoted herein.

Nor can the bearing rollers, as a specific and essential element in appellee's grip, be read out of the claim at this time.

"Our law requires the patentee to specify particularly what he claims to be new, and if he claims a combination of certain elements or parts, we cannot declare that any one of these elements is immaterial. The patentee makes them all material by the restricted form of his claim."

Water Meter Co. vs. Desper, 101 U. S., 337.

"The claims of the patent sued on in this case are claims for combinations. In such a claim, if the patentee specifies any element as entering into the combination, either directly

“ by the language of the claim, or by such a reference to the descriptive part of the specification as carries such element into the claim, he makes such element material to the combination, and the Court cannot declare it to be immaterial. It is his province to make his own claim and his privilege to restrict it. If it be a claim to a combination, and be restricted to specified elements, all must be regarded as material, leaving open only the question whether an omitted part is supplied by an equivalent device or instrumentality.”

Fay vs. Cordesman, 109 U. S., 420.

The rollers of the appellee's grip are described in the specification of the patent as “ *friction rollers* ” (transcript, page 50); they are specifically claimed in three of the claims of the patent. “ There is nothing in the context to indicate that the patentee contemplated any alternative ” for them.

Snow vs. Lake Shore Ry., 121 U. S., 630.

The position may be taken, as it has heretofore been taken on behalf of the appellee, that although there are no friction rollers in the appellant's grip, there is an equivalent therefor in the pins which connect the cross-piece on the foot of the slide with the bell crank jaws. But the testimony of the witnesses and an inspection of the appellant's grip and the patented grip at once dispel this very far fetched idea. Both the grips have the swinging jaws, and both have the slide and the cross-piece on the lower end of the slide, and both have the pins which connect the ends of that cross-piece with the next devices. In the patented grip *the devices which are connected by the pins with the ends of the cross-piece are the friction rollers, while in the appellant's grip the devices which are connected by the pins with the ends of the cross-pieces are the jaws themselves, the friction rollers being left out and nothing being substituted for them.* All this is as plain as that two and two make four. *Both the grips have the pins that connect the ends of the cross-piece with the next devices.* Can the appellee's counsel inform us how he can get along and use the patented grip *without those pins that connect the ends of his cross-bar f^2 with his friction rollers?* *Do we not use those pins or their equivalents to connect the ends of our cross-bar with our jaws direct and thus avoid the use of the rollers entirely and without substituting anything for them?* *Our pins are the substitutes of the pins of the patent, and they are not substitutes of the friction rollers.* Where in the appellant's grip can any friction rollers be applied? If our pins are the equivalents of the friction rollers it must be that we could take the pins out and put the friction rollers in the place of the pins and have them *operate as friction rollers.* But there is no place for friction rollers in our grip. If our pins were taken

out and small friction rollers put in place of them, the rollers would act as pins for connecting the ends of the cross-bar with the jaws and they would not act as friction rollers. They would act as the pins act which are commonly used to connect together the two halves of a hinge. The patented grip has both the pins and the friction rollers. We have the pins only. Before we can be held to have the same combination; both the pins and the friction rollers must be found in our grip. True the pins are not named in the claim as one of the elements of the combination. But they are nevertheless necessary elements of the combination, for without them the rollers would not be held in place. We have already quoted from the patent the description which includes the pins as a necessary part of the combination, and as those pins are a necessary part of the operative combination they are considered as a part of the combination, or else the claim would be void as not being for a combination that was operative for want of something that must be added to the elements specified.

See *Sargeant vs. Hall Safe and Lock Company*, 114 U. S., on page 86 before cited.

Hancock Inspirator Co. vs. Jenks, 21 Federal Reporter, pp. 915 and 916.

Walker on Patents, Sec. 117.

We submit that the element of friction rollers is not in appellant's grip, nor any equivalent for it, and that therefore the combination of claim three is not infringed. This seems so plain as to render superfluous any further discussion of the differences between the wedge-shaped jaws of the patent and the bell-crank jaws of appellant's grip, and other obvious differences that affect the question of infringement.

With the utmost respect for the learned Judge from whose decision this appeal is taken, we think that if the patent sued upon had been construed according to the rules announced and followed by the Supreme Court of the United States, the appeal would have been unnecessary.

Keystone Bridge Co. vs. Phœnix Iron Co., 95 U. S., 274.

Gage vs. Herring, 107 U. S., 648.

Sargeant vs. Hall Safe and Lock Co., 114 U. S., 86.

Phœnix Caster Co. vs. Spiegel, 133 U. S., 368.

Con. Roller Mill Co. vs. Walker, 138 U. S., 132.

We therefore submit that upon a proper construction of the patent the appellant must be held not to have infringed.

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